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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,032	02/08/2002	Richard Dennis Dyer	A0000425-01-CFP	3659
28880	7590	07/05/2005	EXAMINER	
WARNER-LAMBERT COMPANY			TRUONG, TAMTHOM NGO	
2800 PLYMOUTH RD			ART UNIT	PAPER NUMBER
ANN ARBOR, MI 48105			1624	
DATE MAILED: 07/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/071,032	DYER ET AL.
	Examiner	Art Unit
	Tamthom N. Truong	1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3,4,10-21,26,27,29,32,35,38,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4, 10, 15, 17-20 and 35 is/are allowed.
- 6) Claim(s) 3,11,12,14,16,21,26,27,29,32,38,43 and 44 is/are rejected.
- 7) Claim(s) 13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Applicant's amendment of 4-15-05 has been fully considered. Claim 4 has been amended as an independent claim, and thus, no longer lacks antecedent basis. Applicant's argument on the two ranges of "m" has been found persuasive. Therefore, the previous 112/2nd rejections are withdrawn herein.

Claims 1, 2, 5-9, 22-25, 28, 30, 31, 33, 34, 36, 37 and 39-42 have been cancelled.

Claims 3, 4, 10-21, 26, 27, 29, 32, 35, 38, 43 and 44 are pending.

New issues of indefiniteness have been discovered, and thus, raise the following new ground(s) of rejection.

Also, it is noted that claims 3, 11-14, 16, 21, 26, 27, 29, 32, 38, 43 and 44 are not fully supported by the Provisional Application No. 60/268,780. Thus, said claims are not entitled to the earlier filing date of 2-14-2001. Therefore, the reference of **Andianjara et. al.** (WO 02/06480 A2) becomes a competent prior art based on its priority date of 02-14-01.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 3, 11, 21, 26, 27, 29, 32, 38, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. Claims 3, 11 and 32 recites the limitations of “NR⁴R⁵Y” and “NR⁵R⁶Y”.

However, there is no definition for Y. Thus, it is indefinite what the structure of said limitations.

b. Claim 11, in the definition of R⁴, the limitation of “alkenyl” has two different ranges (i.e., “C₂-C₆ alkenyl”, and also “C₂-C₁₀ alkenyl”). It is unclear which range of “alkenyl” is intended.

c. Also, in claim 11, R⁵ has two sets of definitions. In the definition of R², R⁵ represents “hydrogen or methyl”. However, on the following page, R⁵ represents “hydrogen, C₁-C₆ alkyl, substituted C₁-C₆ alkyl, (CH₂)_m aryl, (CH₂)_m substituted aryl, (CH₂)_m heteroaryl, (CH₂)_m substituted heteroaryl.” Therefore, it is unclear which set of R⁵ definition is intended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

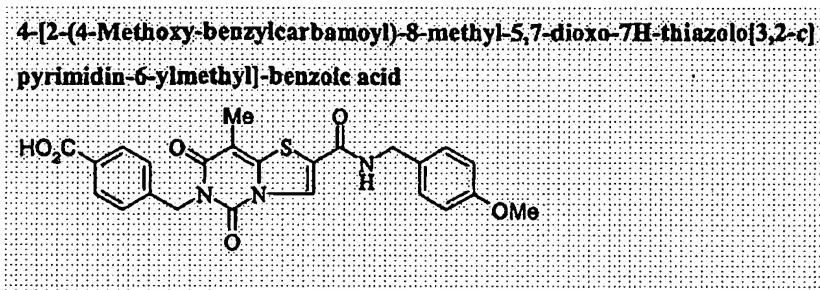
A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 3, 11, 12, 14, 16, 21, 26, 27, 29, 32, 38, 43 and 44 rejected under 35 U.S.C. 102(e) as being anticipated by **Andrianjara et. al.** (WO 02/064080 A2).

On page 32 of WO'080, Synthesis Example 5 discloses the following compound:



Said compound is the same as a compound recited in the instant claim 16 (the third species on page 17 of the amendment). It also reads on formula III with the following substituents:

R¹ is -(O)_n-C₁-alkyl; n = 0 (i.e., R¹ is CH₃);

R² is CONHCH₂aryl (substituted);

R³ is hydrogen;

R⁴ is CH₂ substituted aryl;

Likewise, said compound reads on formula VIII with the following substituents:

R¹ is CH₃;

R² is C(=O)NR⁵(CH₂)_maryl (substituted);

n = 0 and m = 1;

R³ is hydrogen;

R⁴ is (CO₂)_n(CH₂)_m substituted aryl;

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Objections

3. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The subgenus recited in claim 13 has R² as C=C-(CH₂)_maryl; C=C-(CH₂)_msubstituted aryl; C=C-(CH₂)_m heteroaryl; C=C-(CH₂)_m substituted heteroaryl. The teaching of Andrianjara et. al. do not teach or fairly suggest said substituents.

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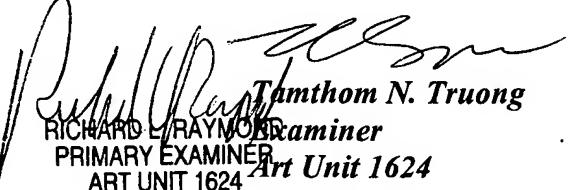
Allowable Subject Matter

4. Claims 4, 10, 15, 17-20 and 35 are allowed. Although WO'080 discloses some species in those claims, said species have support in the Provisional Application No. 60/268,780, and thus, get the earlier filing date of 2-14-2001. Other species are not disclosed or fairly suggested by WO'080.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamthom N. Truong
RICHARD L. RAYMOND Examiner
PRIMARY EXAMINER
ART UNIT 1624

6-27-05